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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,525	10/11/2005	Katsu Kondo	KPO-SUN-P4/SN-89/US	4420
44702	7590	02/09/2011		
OSTRAGER CHONG FLAHERTY & BROITMAN PC			EXAMINER	
570 LEXINGTON AVENUE			STULIL VERA	
FLOOR 17				
NEW YORK, NY 10022-6894				
			ART UNIT	PAPER NUMBER
			1781	
			NOTIFICATION DATE	DELIVERY MODE
			02/09/2011	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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# Office Action Summary

**Application No.**

10/552,525

**Applicant(s)**

KONDO ET AL

**Examiner**

VERA STULII

**Art Unit**

1781

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 August 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 17, 19, 20, 22-30, 32 and 33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17, 19, 20, 22-30, 32 and 33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

As a result of the Petition Decision filed 10/04/2010, the Office Action, mailed 11/12/2010 has been vacated and the time period for response has been restarted as of the mailing date of this Office Action.

#### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 17, 19-20, 22-28, 30, 32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Todorova et al (Obtaining and Applying Extracts of Malt Sprouts in the Production of Beer Wort) hereinafter Todorova.**

**Fertman et al (Use of Malt Sprouts in the Yeast Production) hereinafter Fertman is relied upon as evidence of the extract preparation as discussed below.**

In regard to **claims 32 and 33**, Todorova discloses obtaining malt sprouts extract and further using it in the production of beer (Abstract). Todorova discloses that malt sprouts were obtained as a "waste product of malt production" (page 2 of the translation). Todorova further discloses that malt sprouts extract was obtained "by the method described in the literature [4]" (i.e. Fertman). As evidenced by Fertman, the extract was prepared by:

-obtaining crushed malt sprouts (the by-product of malt industry) (page 2 § 2, page 3 bottom paragraph of the translation);

-adding water to malt sprouts for a period of time to produce immersion liquid (page 3 bottom paragraph of the translation);

- filtering the immersion liquid to remove the malt sprouts (page 4 top paragraph of the translation);

Fertman also discloses that malt sprouts is a source of nitrogen and vitamins (page 2 § 1 of the translation). Fertman further discloses creating optimal conditions for the transfer of these valuable components into the liquid (page 3 § 1 of the translation).

Therefore, steps (a) and (b) are disclosed in Fertman, which is incorporated in Todorova as a reference to the method of preparation of malt sprouts extract. In regard to the step (c) in claim 32, Todorova discloses using malt sprouts extract obtained from the immersion liquid in the production of beer, where malt sprouts extract is used in the production of beer wort to improve its composition (pages 1 and 5 of the translation).

In regard to the controlling particle size of malt sprouts to a certain degree recited in **claims 32, 33, 17 and 20**, the specific surface area of malt sprouts associated with particle size recited in **claims 22 and 32**, the bulk density of malt sprouts associated with particle size recited in **claim 23**, both Todorova and Fertman are silent as to these recitations. Both Todorova and Fertman are silent as to the unpleasant flavor of malt sprouts. Fertman discloses that malt sprouts were crushed and were obtained as a by – product of malt industry. One of ordinary skill in the art would have been motivated to avoid any additional steps of crushing malt particles after the separation from the malted grain, and therefore to obtain uncrushed sprouts or sprouts crushed to a minimal degree as a result of further handling after the separation step. One of ordinary skill in the art would have been motivated to avoid any additional crushing steps associated with additional crushing equipment in order to avoid use of additional crushing

equipment, waste of energy, labor expenses and time consumption associated with operation, maintenance and cleaning of such equipment. One of ordinary skill in the art would have been motivated to avoid any additional crushing steps in order to shorten and simplify the production cycle. All the factors mentioned above would lead to the reduction of malt sprouts cost, which would affect the final cost of the beer beverage, which would positively affect its marketability. It was well known in the art that malt sprouts are used in the form of flour in various applications. However, in the instant case, the malt sprouts are not used in the production of beverage, the immersion liquid is. Therefore, the use of crushed at a high degree malt sprouts is not required. By modifying Todorova to exclude the crushing step set forth above and for the reasons employed therein, it is inherent that particle size of malt sprouts, the specific surface area of malt sprouts associated with particle size and the bulk density of malt sprouts associated with particle size, the flavor of malt sprouts would be as claimed. Further, in regard to the recitation of unpleasant flavor in claims 32 and 20, it is noted that Todorova et al discloses further removing the malt sprouts after the immersion step during the soluble extract preparation (p.17).

In regard to **claim 19**, Fertman discloses removal of malt sprouts after the immersion step by filtering the immersion liquid (page 4 top paragraph of the translation).

In regard to **claims 24-26, 28 and 30**, Todorova et al discloses production of beer beverage.

In regard to **claim 27**, Todorova is silent as to the amount of immersion liquid used in the preparation of wort. However, Todorova discloses balancing the content of amino nitrogen and metallic ions in the beer must (i.e. wort). Therefore, one of ordinary skill in the art would have been motivated to vary amount of the immersion liquid included in the wort composition, depending on the initial content of the amino nitrogen and metallic ions in the beer wort and the final desired value of these substances in the beer wort. Hence, the amount of immersion liquid used for the preparation of the beer wort would depend on the degree of amino nitrogen and metallic ions disbalance in beer wort.

**Claims 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Todorova in view of Takaichi et al (US 6,251,457) hereinafter Takaichi.**

Todorova is taken as cited above. Todorova discloses that obtained malt sprouts extract has a high content of amino nitrogen (page 5 of the translation). Todorova et al also discloses that malt sprouts extract contains various amino acids and metallic cations (minerals such as zinc, manganese, copper and magnesium (Pages 4-7 of the translation). Todorova is silent as to the use of malt sprouts extract in the production of the soft beverages. Takaichi discloses preparation of powdered soft drink by addition of amino acid and minerals (Col. 3 lines 17-41). Thus, one of ordinary skill in the art would have been motivated to modify Todorova in view of Takaichi and to use malt sprouts extract in the preparation of the soft beverage as taught by Takaichi. One of ordinary skill in the art would have been motivated to do so in order to increase nutritional value of the beverage by addition of vitamins and amino acids as taught by Takaichi.

***Response to Arguments***

The rejection of claims under 35 U.S.C. 112, second paragraph has been withdrawn due to the claims amendments.

Applicant's arguments with respect to claims under 35 U.S.C. 102(b) and 35 U.S.C. 103(a) have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VERA STULII whose telephone number is (571)272-3221. The examiner can normally be reached on 7:00 am-3:30 pm, Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on (571) 272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Vera Stulii/  
Examiner, Art Unit 1781

/Keith D. Hendricks/  
Supervisory Patent Examiner, Art Unit 1781